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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/029,180	12/22/2001	Brian M. Cali	MIC-004 (1003/005)	4615

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Anita L. Meiklejohn, Ph.D.  
FISH & RICHARDSON P.C.  
225 Franklin Street  
Boston, MA 02110-2804

EXAMINER
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MCKELVEY, TERRY ALAN

ART UNIT	PAPER NUMBER
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1636

DATE MAILED: 01/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

SM

**Office Action Summary**

SM

**Application No.**

10/029,180

SM

**Applicant(s)**

CALI ET AL.

**Examiner**

Terry A. McKelvey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-68 is/are pending in the application.
- 4a) Of the above claim(s) 2-4,6-55,57,58,60-65,67 and 68 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 56 is/are rejected.
- 7) ☒ Claim(s) 1,5,59 and 66 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5/02, 1/03. 6) ☐ Other: \_\_\_\_\_

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**DETAILED ACTION**

***Election/Restrictions***

Applicant's election without traverse of Group I, An09 (SEQ ID NO:7), claims 1, 5, 56, 59, and 66 in the paper filed 10/24/03 is acknowledged.

Claims 2-4, 6-55, 57, 58, 60-65, 67, and 68 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the paper filed 10/24/03.

Claims 1, 5, 56, 59, and 66 contain non-elected subject matter (drawn to non-SEQ ID NO:7 sequences) which is not subject to rejoinder. It is suggested that the non-elected subject matter be removed by amendment to place the claims in better form for prosecution of the elected subject matter.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 56 is rejected under 35 U.S.C. 102(b) as being anticipated by Kupfer et al (AA785001).

Kupfer et al teach an isolated cDNA sequence which is 98.5% similar to SEQ ID NO:7 over a stretch of about 390 nucleotides. See the reference which shows the sequence alignment. This high degree of similarity is sufficient for hybridization of the Kupfer et al sequence (actually the other strand of the double-stranded cDNA sequence that is shown) to SEQ ID NO:7. This qualifies as an isolated or recombinant nucleic acid that is specifically complementary to (An09 (SEQ ID NO:7)) as per the definition of "specifically complementary" as set forth in the specification.

#### ***Double Patenting***

Claims 5 and 59 are objected to under 37 CFR 1.75 as being a substantial duplicate of claim 1. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

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Claim 5 is drawn to the only elected part of claim 1. After deletion of the non-elected subject matter of claim 1 which is necessary prior to allowance, claim 5 will have the same scope as amended claim 1 (drawn to An09 (SEQ ID NO:7) gene) and thus claim 5 would be a substantial duplicate of claim 1.

Claim 59 is drawn to an isolated or recombinant gene that regulates FLO11 expression selected from the group consisting of (only drawn to An09 (SEQ ID NO:7) after amendment to remove the non-elected subject matter). The final claim drawn to only elected subject matter is identical in scope (drawn to An09 (SEQ ID NO:7)) as amended claim 1. The preamble merely indicates an inherent property of An09 (SEQ ID NO:7) and thus has no effect on the structure of the claimed gene.

#### ***Claim Objections***

Claims 5 is objected to because of the following informalities: the claim has an extra period after the claim number. Appropriate correction is required.

#### ***Allowable Subject Matter***

Claims 1 and 66 are objected to as comprising or being dependent upon a claim that contains non-elected subject matter,

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but would be allowable if rewritten to delete non-elected subject matter.

### **Conclusion**

No claims are allowed.

Certain papers related to this application may be submitted to Art Unit 1636 by facsimile transmission. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 C.F.R. § 1.6(d)). The official fax telephone number for the Group is 703-872-9306. NOTE: If Applicant does submit a paper by fax, the original signed copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office.

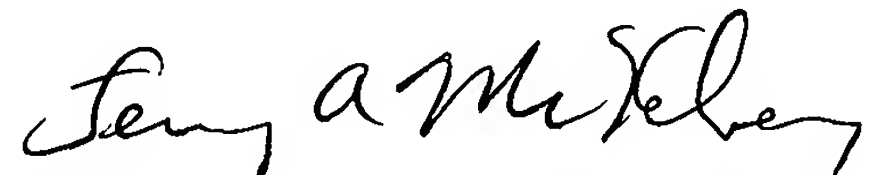
Any inquiry concerning rejections or other major issues in this communication or earlier communications from the examiner should be directed to Terry A. McKelvey whose telephone number is (703) 305-7213 until January 14, 2004, and (571) 272-0775 after January 14, 2004. The examiner can normally be reached on Monday through Friday, except for Wednesdays, from about 7:30 AM to about 6:00 PM. A phone message left at this number will be

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responded to as soon as possible (i.e., shortly after the examiner returns to his office).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Remy Yucel can be reached on (703) 305-1998.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



**Terry A. McKelvey, Ph.D.**  
**Primary Examiner**  
**Art Unit 1636**

January 12, 2004